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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,423	12/08/2003	Janine M. Orban	1671-0279	2485

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Maginot, Moore & Beck LLP
Chase Tower, Suite 3250
111 Monument Circle
Indianapolis, IN 46204-5109

EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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06/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/730,423

Applicant(s)

ORBAN ET AL.

Examiner

DAVID COMSTOCK

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13, 15-21, 23, 24, 26, 27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6 and 7 is/are allowed.
- 6) ☒ Claim(s) 8-13, 15-21, 23, 24, 26, 27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The drawings do not show an embodiment wherein a dome portion is surrounded by a rim, as now claimed in new claim 30. Moreover, the description does not appear to have support for this new limitation. Accordingly, the claim should be canceled or proper support should be shown in the next reply to the Office.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-13, 15-17 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Overaker (6,371,958; cited by applicant).

Overaker discloses an implant scaffold device comprising an upper plate 82, a lower plate 84 and a load transfer structure 88 therebetween. The load transfer

structure comprises individual supports with attachment structures 90 that are press fit into bores 103 in the lower plate. A fixation tube 170 extends from the lower plate and includes radially extending flanges or barbs 174 (see Fig. 21). The plates comprise a center bore, e.g. 24, and surrounding exposure bores, e.g. 22. The device is formed from porous resorbable polyester (see, e.g., col. 1, lines 5-20 and col. 7, lines 54-58). The assembled device can be considered integral and unitary. The device comprises a domed edge portion defining a convex surface against which an object is capable of articulating. As the edge portion extends circumferentially across the plate, so too does the convex dome surface thereof. The outermost lateral edge can be seen as the claimed rim surrounding the domed portion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-21, 23, 24, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Overaker (6,371,958; cited by applicant) in view of Schwartz et al. (5,769,899).

Overaker discloses the claimed invention except for explicitly reciting that the supports comprise rectangular walls extending radially outwardly. Schwartz et al. disclose a similar device comprising rectangular walls extending radially outwardly (see,

e.g., Fig. 2). Thus, this is a known configuration in the art and would amount to nothing more than a simple substitution of a known configuration to obtain predictable results. Moreover, doing so would make the device more familiar and acceptable (e.g., for purchase) by surgeons already using the Schwartz et al. device. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the implant of Overaker with supports comprising rectangular walls extending radially outwardly in view of Schwartz et al. as doing so amounts to nothing more than a simple substitution of a known configuration to obtain predictable results. Moreover, as already noted, doing so would make the device more familiar and acceptable (e.g., for purchase) by surgeons already using the Schwartz et al. device.

Allowable Subject Matter

Claims 1-4, 6 and 7 are allowed. Applicant's arguments with respect to independent claim 1, see Remarks filed 23 March 2009, e.g., page 9, lines 6-10, are persuasive for the reasons advanced by Applicant.

Response to Arguments

Applicant's arguments filed 23 March 2009 have been fully considered but they are not fully persuasive.

The Overaker reference is still seen as satisfying the claims that remain rejected. The plates comprise flat surfaces that can be seen as narrow plate surfaces, which extend substantially across one side of the second plate. As the supports have at least

some length, they can be seen as being elongated in the absence of any specific further dimension. The dome portion is convex and extends substantially across an upper surface of the upper plate, since the dome portion is formed as a part of the surface and the surface extends circumferentially across the plate. The supports comprise walls that extend radially outward and are longer than other walls of the support (e.g., the lateral inner channel walls vis-à-vis the walls adjacent the inner vertical vertices). Regarding the dome limitation, it is noted that Applicant did not simply claim a dome; but rather, a dome portion was claimed. A dome is a well-known round, curved surface and the prior art shows at least a portion of a round curved surface, i.e., a dome portion. Moreover, that portion extends circumferentially across the plate.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/
Examiner, Art Unit 3733
/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733